

REMARKS

Claim 3 was objected to for being unclear as to whether the step of inserting is part of, or different than, the step of encapsulating.

Claims 1, 6, 9, and 15 were rejected under 35 U.S.C. 102(b) as being anticipated by Benjamin *et al.*, U.S. Pat. 4,793,825 ('825).

Claims 1, 3, 5-6, 8, 9, and 14-15 were rejected under 35 U.S.C. 103(a) as being unpatentable over Benjamin *et al.*, U.S. Pat. 4,793,825 ('825).

Claim 4 was rejected under 35 U.S.C. 103(a) as being unpatentable over Benjamin *et al.*, U.S. Pat. 4,793,825 ('825) in view of Kopelman *et al.*

Claims 11 and 12 were rejected under 35 U.S.C. 103(a) as being unpatentable over Benjamin *et al.*, U.S. Pat. 4,793,825 ('825) in view of Ostensen *et al.*, U.S. Pat. 6,375,931 ('931).

Claim 13 was rejected under 35 U.S.C. 103(a) as being unpatentable over Benjamin *et al.*, U.S. Pat. 4,793,825 ('825) in view of Ostensen *et al.*, as applied to claim 12 above, and further in view of Chandrakumar *et al.*, U.S. Pat. 6,472,874 ('874).

Claim 16 was rejected under 35 U.S.C. 103(a) as being unpatentable over Benjamin *et al.*, U.S. Pat. 4,793,825 ('825) in view of Schechter *et al.*, U.S. Pat. 4,120,649 ('649).

Claims 17-19 were rejected under 35 U.S.C. 103(a) as being unpatentable over Benjamin *et al.*, U.S. Pat. 4,793,825 ('825) in view of Dustin *et al.*, U.S. Pat. 5,071,964 ('964) or Li *et al.*, U.S. Pat. 6,090,408 ('408).

Applicants respectfully traverse the claim objections, the §102(b) rejections, and §103(a) rejections with the following arguments.

Claim Objections

Claim 3 was objected to for being unclear. Accordingly, Applicants have amended claim 3.

**35 U.S.C. §102(b)**

The Examiner rejected claims 1, 6, 9, and 15 under 35 U.S.C. 102(b) as allegedly being anticipated by Benjamin *et al.*, U.S. Pat. 4,793,825 ('825).

Applicants respectfully traverse the Examiner's rejection of claim 1, because '825 does not teach each and every feature of Applicants' claim 1. For example: the '825 reference does not teach introducing by injection or reverse osmotic lysis at least one of said microdevice and said nanodevice as in Applicants claim 1. Applicants submit that nowhere does '825 teach injection or reverse osmotic lysis of microdevices and nanodevices. In contrast, Applicants respectfully submit that '825 teaches encapsulating. See column 15, lines 33-34, as recited in the Office Action, page 2, paragraph 5.

The Examiner argues that the method disclosed in the '825 reference for encapsulating a microdevice within a white blood cell does not preclude the use of other cell types. See Id. Applicants respectfully contend that encapsulation / phagocytosis of a microdevice or nanodevice by white blood cells is very different from injection or reverse osmotic lysis to introduce said microdevice or nanodevice. Applicants' specification discloses injection or reverse osmotic lysis to transport microdevices or nanodevices into a cell. See Applicants' Specification, pages 10-12. Applicants respectfully contend introduction of microdevices into cells as taught by Benjamin *et al.* is completely different because encapsulation is not injection or reverse osmotic lysis.

In light of the foregoing, Applicants respectfully submit that claim 1 is in condition for allowance because Benjamin *et al.* do not teach injection or reverse osmotic lysis to introduce microdevices and nanodevices. Claims 6 and 9 are likewise in condition for allowance, since

claims 6 and 9 depend from claim 1.

The Examiner rejected claims 1, 6, 9, and 15 under 35 U.S.C. 102(b) as allegedly being anticipated by Benjamin *et al.*, U.S. Pat. 4,793,825 ('825). Applicants respectfully traverse the Examiner's rejection of claim 15 because the '825 reference does not teach each and every feature of claim 15. For example: the '825 reference does not teach *inter alia* "encapsulating the at least one of said microdevice and said nanodevice, wherein the at least one of said microdevice and said nanodevice is extracellular," as in Applicants' claim 15.

In light of the foregoing, Applicants respectfully submit that claim 15 is in condition for allowance because Benjamin *et al.* do not teach *inter alia* extracellular encapsulation of microdevices and nanodevices.

35 U.S.C. §103(a)

Claims 1, 3, 5-6, 8, 9, and 14-15 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Benjamin *et al.*, U.S. Pat. 4,793,825 ('825).

Applicants respectfully traverse the Examiner's rejection because the '825 reference does not teach or suggest each and every feature of claims 1 and 15.

As to claim 1, Applicants submit that the Examiner's rejection fails because the Examiner does not cite where the '825 reference teaches or suggests "introducing by a method selected from the group consisting of reversible osmotic lysis, electroporation, microfine needle injection, and particle gun injection at least one of said microdevice and said nanodevice," as in Applicants' claim 1. Therefore, Applicants contend the Examiner has failed to meet his burden of proof to satisfy the rejection of claim 1 under 35 U.S.C. §103(a).

As to claim 15, Applicants submit that the Examiner's rejection fails because the Examiner does not cite where the '825 reference teaches or suggests "encapsulating at least one of said microdevice and said nanodevice, wherein the at least one of said microdevice and said nanodevice is extracellular" as in Applicants' claim 15. Therefore, Applicants contend the Examiner has failed to meet his burden of proof to satisfy the rejection of claim 15 under 35 U.S.C. §103(a).

Applicants respectfully submit that the Examiner's rejections of claims 11, 12, which depend from independent claim 1, and 16-19, which depend from independent claim 15, under 35 U.S.C. §103(a) over Benjamin *et al.* in combination with the Examiner's other cited prior art fail for the same reason that Applicants used to overcome the Examiner's rejection of claims 1 and 15, *supra*.

In light of the foregoing, Applicants respectfully submit that claims 1, 3, 5-6, 8-9, 11-12, and 14-19 are in condition for allowance under 35 U.S.C. §103(a) over Benjamin *et al.*, either alone or in combination with the Examiner's other cited prior art because the Examiner's cited prior art does not teach or suggest the inventions claimed in independent claims 1 and 15.

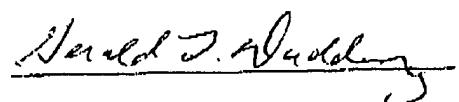
09/727,718

12

CONCLUSION

Based on the preceding arguments, Applicants respectfully believe that all pending claims and the entire application meet the acceptance criteria for allowance and therefore request favorable action. If the Examiner believes that anything further would be helpful to place the application in better condition for allowance, Applicants invites the Examiner to contact Applicants' representative at the telephone number listed below. The Director is hereby authorized to charge and/or credit Deposit Account No. 19-0513.

Date: December 27, 2004



Gerald F. Dudding  
Registration No. 52835

Schmeiser, Olsen & Watts  
3 Lear Jet Lane, Suite 201  
Latham, New York 12110  
(518) 220-1850